REMARKS

This responds to the non-final Office Action dated 22 May 2008. Claims 1, 3-7, 10-18, 21, and 22 are pending in the application. Claims 1, 3-7, 10-18, 21, and 22 stand rejected. Claim 1 has been amended to provide additional clarity. Applicant respectfully requests reconsideration in light of the following remarks.

Lack of Clarity in Examiner's Rejections

As noted in Applicant's response to the non-final Office Action dated 28 November 2007, the rejections of claims 4-6, 13, 14, 21, and 22 were unclear. Examiner did not respond to Applicant's concerns. As discussed in greater detail in the remarks, the pertinence of the cited references that Examiner relied upon in the rejections of claims 4-6, 13, 14, 21, and 22 has not been clearly explained as required by 37 C.F.R. § 1.104(c)(2). Applicant requests clarification.

Amendments to the Specification

Applicant has amended the specification in accordance with MPEP 608.01(v).

Examiner's Comment Regarding Claim 18

Examiner fails to set forth an appropriate basis for rejecting claim 18. Instead, Examiner states, "Official notice is taken that User-defined profiles recited in this claim is only data limitation that is included but does nothing in the claim." *Office Action*, p. 10. Applicant disagrees with Examiner's assertion that "User-defined profiles . . . does nothing in the claim." Furthermore, the purpose of "official notice" is not to allow an examiner to make a baseless assertion that an element "does nothing in [a] claim," but is a procedure for making a rejection based on common knowledge or facts not in the record. *See MPEP 2144.03.*

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As explained in the MPEP, "[o]fficial notice unsupported by documentary evidence should *only* be taken by the Examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of *instant and unquestionable demonstration* as being well-known." *MPEP 2144.03* (emphasis added). Moreover, "[a]llegations concerning specific 'knowledge' of the prior art, which might be peculiar to a particular art should also be supported and the appellant similarly given the opportunity to make a challenge." *In re Pardo and Landau*, 684 F.2d 912, 917, 214 USPQ 673, 677 (CCPA 1982). The Federal Circuit has also held that the Patent Office must demonstrate that the alleged support existed at the time the claimed invention was made. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1093, 231 USPQ 375, 379 (Fed. Cir. 1986).

Thus, if Examiner believes that claim 18 still reads on a prior art reference, Applicant hereby requests that Examiner:

> (a) Provide another non-final Office Action withdrawing Official Notice and applying a suitable reference for the asserted rejection;

> (b) Issue another rejection under an appropriate statutory provision and provide an affidavit or suitable reference attesting to all the elements taken as Official Notice; or

> (c) Withdraw the asserted rejection.

By this reply, Applicant has timely challenged Examiner's Official Notice and respectfully requests that claim 18 be allowed.

Restriction & Election of Species

Applicant acknowledges the election of claims 1, 3-7, 10-18, 21, and 22 with traverse and without acquiescing to any of Examiner's characterizations of the claims or

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subject matter of the present application. Applicant also reserves the right to pursue the

subject matter of withdrawn claims 23-25 in a separately filed divisional application.

Claim Rejections – 35 U.S.C. § 112

Claims 1, 3-7, 10-18, 21, and 22 are rejected under 35 U.S.C. § 112 as being

indefinite for failing to particularly point out and distinctly claim the subject matter

which Applicant regards as the invention. Applicant respectfully traverses these

rejections.

"Console" is Not Indefinite

The term "console" is not indefinite. However, Examiner states that "the

specification clearly uses [console] without any description." *Office Action*, p. 2.

Examiner reasons that:

> Since the remarks contend the Examiner's address as the Window together
> with programs that make Winzip acting the word 'console'. It does not
> know what the 'console' of the specification is. Since the term scanning
> the device is the act of running the file system, particularly provided by
> MS-DOS, it is not clearly what is the applicant's console, whether it is the
> same with the standard console as shown by the Microsoft dictionary or
> not.

Office Action, p. 5. Applicant requests clarification because Examiner's reasoning in

the cited paragraph is unclear.

Examiner's analysis does not appear to take into consideration that "[a]

fundamental principle contained in 35 U.S.C. § 112, second paragraph is that applicants

are their own lexicographers." MPEP § 2173.01. The MPEP further notes,

> [Applicants] can define in the claims what they regard as their invention
> essentially in whatever terms they choose so long as 'any special meaning
> assigned to a term is clearly set forth in the specification.' *See MPEP §
> 2111.01.* Applicant may use functional language, alternative expressions,
> negative limitations, or any style of expression or format of claim which
> makes clear the boundaries of the subject matter for which protection is
> sought. As noted by the court in *In re Swinehart*, 439 F.2d 210, 160 USPQ

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226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought."

MPEP § 2173.01. The meaning of the term console is clear in both the claims and the specification. For example, the specification recites, "The Console is run on the Source PC. . . . This executable program scans the drive(s) for the environment settings and files to be migrated and builds the STAMPs." *Specification,* ¶ 0076. Similarly, claim 1 recites that "said console [is] configured to scan said first computer for said files and settings to be migrated to said second computer." Thus, the meaning of the term "console" is not indefinite and Applicant requests withdrawal of the § 112 rejection of the term "console."

"Scan said First Computer" is not Indefinite

The phrase "scan said first computer" is not indefinite. However, Examiner asserts that "application does not show what is meant by 'scan a computer.'" *Office Action,* p. 3. Examiner's concern appears to be that "it is only a term used without describing how the computer is scanned." *Office Action,* p. 2. Applicant notes that Examiner's statement, even if correct (which Applicant does not concede), fails to provide a basis for rejecting the claims under 35 U.S.C. § 112. "The requirement to 'distinctly' claim means that the claim must have a meaning discernible to one of ordinary skill in the art when construed according to correct principles. . . . Only when a claim remains insolubly ambiguous without a discernible meaning after all reasonable attempts at construction must a court declare it indefinite." *Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings,* 370 F.3d 1354, 1366, 71 USPQ2d 1081, 1089 (Fed. Cir. 2004).

Claim 1 is not "insolubly ambiguous without a discernible meaning after all reasonable attempts at construction." The specification describes "scan a computer" and further, one of ordinary skill in the art would recognize that there are numerous well-known techniques that may be used to scan a computer. Thus, the meaning of the phrase "scan said first computer" is not indefinite and Applicant requests withdrawal of the § 112 rejection of the phrase "scan said first computer."

Claim Rejections – 35 U.S.C. § 103

In the Action, claims 1, 3-7, 10-18, and 21-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Nico Mak's Computing, Inc, WinZip Version 7.0 ("Nico Mak"), in view of "Go inside WinZip 7.0," by Tom O'Connell ("O'Connell"), and further in view of "Total Virus Defense Suite – Best Practices Guide – Migration Technical Manual" Ver. 4.x by Network Associates, Inc. ("Network Associates").

35 U.S.C. § 103(a) recites, in part,

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

To establish prima facie obviousness of a claimed invention, *all* the claim limitations must be taught or suggested by the prior art. *See, e.g., In re Royka*, 490 F.2d 981, 985 (CCPA 1974); *accord.* MPEP § 2143.03 ("To establish a *prima facie* case of obviousness ... the prior art reference (or references when combined) must teach or suggest *all* the claim limitations.") (emphasis added). Applicant respectfully submits that the cited references, even if combined, do not establish a *prima facie* case of obviousness because they do not show, teach or suggest all claimed features.

The Cited References to Teach Various Features of Claim 1

Nico Mak, O'Connell, and Network Associates, fail to teach various features of claim 1. None of Nico Mak, O'Connell, or Network Associates teaches or suggests an application interface file, a console configured to scan a computer, or a self-extracting auto-migration package, as recited in claim 1.

Nico Mak, in view of O'Connell and Network Associates, fails to teach "an application interface file identifying how to convert said files and settings from said first version to said second version of said application program," as recited in claim 1. According to Examiner, an application interface file "is in a self extract WinZip file, sent from a computer to another computer, this file provides the features as discussed in WinZip Version 7.0 of Nico Mak, such as an .ini file or using registry." *Office Action*, p. 7. Examiner's argument is unclear. Furthermore, Applicant is unable to find anywhere that Nico Mak teaches that a .ini file (or any other file) identifies how to convert settings from a first version of an application program to a second version of an application program. O'Connell and Network associates do not remedy this deficiency of Nico Mak. Therefore, claim 1 distinguishes over the cited references for at least this reason.

Nico Mak, in view of O'Connell and Network Associates, fails to teach a "console configured to scan said first computer for said files and settings to be migrated to said second computer," as recited by claim 1. Examiner apparently cites page 5 of O'Connell, although Examiner's source is not clear. O'Connell, p. 5, teaches that a user may "select the file(s) you want to compress" to add to a ZIP file. However, the cited O'Connell passage does not teach or suggest *scanning* a first computer for settings to be migrated to a second computer. Examiner argues that "putting files in the Zip file

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. . . is only another expression of 'scanning.'" *Office Action*, p. 3. Applicant disagrees. One of ordinary skill in the art would not equate a user putting files in a Zip file, which is taught in O'Connell, to a scanning process performed by a computing console. Further, O'Connell does not even mention settings, much less scanning for settings, as recited in claim 1. Both Nico Mak and Network Associates fail to remedy these deficiencies of O'Connell.

Examiner argues that "to disclose for this inherent acts of using a console for scanning computer before migrating files from an UnZip package to the computer, [Network Associates] discloses performing the scan of all the drives available to the system." *Office Action*, p. 8. Examiner's support for this conclusion is that Network Associates "provides various scanning including to scan the registry for setting up file migration (i.e. Title: Migration Technical Manual). However, the preface in Network Associates notes that the Network Associates reference "specifically addresses the issue of migration to Total Virus Defense version 4 and gives advice and examples as to how to this can best be accomplished." *Network Associates*, p.2. In other words, Networks Associates discusses migrating (*i.e.*, updating) "from existing Anti-virus Toolkit and VirusScan 3.x to TVD SuiteVersion 4." *Id.* In contrast, claim 1 is directed to "migrating files and settings associated with said application program from said first computer to said second computer." Thus, the migration discussed in Network Associates is not comparable to the migration recited in claim 1.

Nico Mak, in view of O'Connell and Network Associates, fails to teach a "self-extracting auto-migration package further comprising said files and settings for migration to said second computer," as recited in claim 1. Examiner, without citing any supporting sources, argues that a "self-extracting auto-migration package comprising

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said files and settings" is "any .ZIP file created by WinZip 7.0." *Office Action*, p. 8. The only reference to settings among sources cited by Examiner is in Nico Mak, which teaches that "WinZip now uses the registry instead of winzip32.ini." *Nico Mak*, p. 1. However, none of Nico Mak, O'Connell, or Network Associates teach or suggest that a .ZIP file contains "settings for migration" obtained by "scanning said first computer."

Applicants also note that the specification teaches that Self-exTracting Auto-Migrate Packages (STAMPs) contain "the intelligence needed to write files to the appropriate destination and to make the appropriate registry changes." *Specification,* ¶ 0077. Examiner has not shown where any of the cited references shows, teaches, or suggests that .ZIP files contain intelligence needed to write files to the appropriate destination and to make the appropriate registry changes to update a second version of an application program on a second computing system with files and settings of a first version of the application program on a first computing system. Examiner has failed to establish a prima facie case of obviousness for at least this reason.

For at least the reason that the cited references fail to teach or suggest all the features of claim 1, Applicant respectfully submits that claim 1 is allowable. Claims 4-7 and 10-18 depend from claim 1 and are allowable for at least the same reasons that claim 1 is allowable. Thus, Applicant requests withdrawal of the rejections of claims 1, 4-7, and 10-18 and submits that these claims are in condition for allowance.

The Cited References Fail to Teach Various Features of Claim 3

Nico Mak, O'Connell, and Network Associates fail to teach or suggest various features of claim 3. For example, the cited references do not teach a "Personality Package comprising user settings, user preferences, application programs and data files for migration from a source computer to a destination computer," as recited by claim 3.

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With respect to this feature of claim 3, Examiner argues, "[A]ll the content used to packed in the WinZip file; *i.e.* a created zipped file having, 'Something or Other zip.'" *Office Action.* p. 11. In addition to the absence of a cited source for Examiner's argument, it is unclear how Examiner's statement relates to "user settings, user preferences, application programs and data files for migration."

Claim 3 also recites that the "Personality Pack correspond[s] to specified application versions." Examiner argues, "*i.e.* a package of an application used to stored in a directory such as seen in O'Connell, p. 4." *Office Action*, p. 11. However, Applicant could not find any passage in O'Connell p. 4, or anywhere in O'Connell, that relates to "Personality Pack corresponding to specified application versions." Further, it is unclear how Examiner's statement relates to "specified application versions." Nico Mak and Network Associates both fail to remedy this deficiency.

The cited references fail to teach or suggest "generating an error if said destination application versions do not match," as recited by claim 3. Examiner argues, "Nico Mak, provides configuration that improves a user manually installing the features of the WinZip application into a computer. Where installing error is generated based on the Windows operating system, the act of getting application version specifics is only a manual act performed by a user." *Office Action*, p. 12. Examiner fails to cite a source for his argument. Further, Examiner appears to argue that a user can manually discover application versions after an error. In contrast, claim 3 recites, "*generating* an error if said destination application versions to not match." O'Connell and Network Associates both fail to remedy this deficiency.

For at least the reason that Nico Mak, in view of O'Connell and Network Associates, fails to teach or suggest all the features of claim 3, Applicant respectfully

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submits that claim 3 is allowable. Claims 21 and 22 depend from claim 3 and are allowable for at least the same reasons that claim 3 is allowable. Thus, Applicant requests withdrawal of the rejections of claims 3, 21, and 22, and submits that these claims are in condition for allowance.

Nico Mak does not Disclose the Executable Program Recited in Claim 4

As previously noted, claim 4 depends from claim 1 and distinguishes over Nico Mak, O'Connell, and Network Associates for at least the same reasons that claim 1 distinguishes over these references. Claim 4 further distinguishes over Nico Mak, O'Connell, and Network Associates by reciting that the console further comprises "an executable program that scans for environment settings and files to be migrated and builds said self-extracting auto-migration packages."

Examiner's rejection of claim 4 is unclear. With respect to claim 4, Examiner states, "Nico Mak discloses the WinZip with Drag and Drop, 'File Properties' for creating self-extractor packages." *Office Action*, p. 9. It is unclear how Examiner's statement relates to "an executable program that scans for environment settings and files to be migrated" or an executable program that "builds said self-extracting auto-migration packages." Applicant submits that the cited references do not teach an executable program "capable of scanning for environment settings and files and building a self-extracting auto-migration package," as recited in claim 4.

Nico Mak Does Not Disclose a Console Edit Function Recited in Claim 5

As previously noted, claim 5 depends from claim 1 and distinguishes over Nico Mak, O'Connell, and Network Associates for at least the same reasons that claim 1 distinguishes over these references. Claim 5 further distinguishes over Nico Mak, O'Connell, and Network Associates by reciting that the console comprises an edit

function. With respect to claim 5, Examiner states, "Nico Mak discloses WinZip which is adaptable to a standard Window like Window 95, editable by a 'File Properties.'" *Office Action*, p. 9. It is unclear how a "standard Window" is relevant to the edit function recited in claim 5. Applicant submits that the cited references do not teach the edit function recited in claim 5.

The Office Action Does Not Clearly Address the Features of Claim 6

As previously noted, claim 6 depends from claim 1 and distinguishes over Nico Mak, O'Connell, and Network Associates for at least the same reasons that claim 1 distinguishes over the these references. Claim 6 further distinguishes over Nico Mak, O'Connell, and Network Associates by reciting that the console further comprises "a filter for determining which settings and file types are to be included in said self-extracting auto-migration package." The Office Action states, "With regard to limitation of Claim 6, see all commands shown in page 2." *Office Action*, p. 9. It is unclear to which reference the Office Action refers. Furthermore, it is unclear how any of the commands in the cited references are comparable to the filter recited in claim 6.

The Office Action Does Not Clearly Address the Features of Claim 13

As previously noted, claim 13 depends from claim 1 and distinguishes over Nico Mak, O'Connell, and Network Associates for at least the same reasons that claim 1 distinguishes over these references. Claim 13 further distinguishes over Nico Mak, O'Connell, and Network Associates by reciting that "said self-extracting auto-migration package includes an operating system conversion capability." Examiner states, "With regard to limitation of Claim 13, Buttons EXTRACT in the ZIP file." *Office Action*, p. 10. It is unclear how the extract button in WinZip is related to the operating system

conversion capability recited in claim 13. Applicant submits that the cited references fail to teach the operating system conversion capability recited in claim 13.

The Office Action Does Not Clearly Address the Features of Claim 14

As previously noted, claim 14 depends from claim 1 and distinguishes over Nico Mak, O'Connell, and Network Associates for at least the same reasons that claim 1 distinguishes over the cited references. Claim 14 further distinguishes over Nico Mak, O'Connell, and Network Associates by reciting that "said self-extracting auto-migration package includes disk space verification." Examiner states, "With regard to limitation of claim 14, associated with Windows commands." *Office Action*, p. 10. It is unclear which commands in the cited references are related to disk space verification. Applicant submits that the cited references fail to teach a self-extracting auto-migration package with disk space verification.

The Office Action Does Not Clearly Address the Features of Claim 21

As previously noted, claim 21 depends from claim 3 and distinguishes over Nico Mak, O'Connell, and Network Associates for at least the same reasons that claim 3 distinguishes over the cited references. Claim 21 further distinguishes over Nico Mak, O'Connell, and Network Associates by reciting "determining whether said file is a shell link" and "if said file is a shell link, adding said file to a shell link list." Examiner argues that the "shell links is part of the Windows operating system." *Office Action*, p. 13. However, Examiner fails to point to any teaching or suggestion of "determining whether said file is a shell link" or "adding said file to a shell link list" if the file is a shell link.

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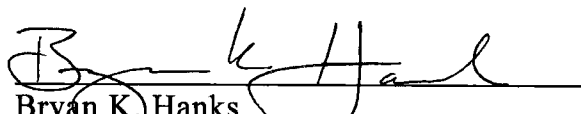*The Office Action Does Not Clearly Address the Features of Claim 22*

As previously noted, claim 22 depends from claim 3 and distinguishes over Nico Mak, O'Connell, and Network Associates for at least the same reasons that claim 3 distinguishes over these references. Claim 22 further distinguishes over Nico Mak, O'Connell, and Network Associates by reciting "updating shell links in said destination computer using said shell link list." With respect to this feature, Examiner states that "WINZIP 7.0 or WINZIP are embedded in Windows, where shell links is part of the Windows operating system." *Office Action*, p. 13. Examiner's statement does not address the functionality of updating shell links in a destination computer using shell link lists. Furthermore, the cited references do not teach updating shell links in a destination computer using a shell link list, as recited in claim 22.

<u>CONCLUSION</u>

For at least the foregoing reasons, Applicant believes that each of the presently pending claims in this application is in immediate condition for allowance. Accordingly, Applicant respectfully requests a favorable action on the merits. If Examiner has any further comments or suggestions, Applicant invites Examiner to contact the undersigned attorney to expedite the handling of this matter.

Respectfully submitted,

Date: __1 August 2008__

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